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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,798	12/05/2003	Roy Hirst	13768.1382	2266
47973 7590 06/17/2010 WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111				
EXAMINER				
PEARSON, DAVID J				
ART UNIT		PAPER NUMBER		
2437				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,798

Applicant(s)

HIRST, ROY

Examiner

DAVID J. PEARSON

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. Claims 1, 6, 11, 16 and 21 have been amended. Claims 1-17 and 20-25 have been examined.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/24/2010 has been entered.

Response to Arguments

3. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 11-17 and 20-23 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11-17 and 20 are directed towards "A computer-readable storage medium ...". One of ordinary skill would recognize a computer readable storage medium could be a carrier wave. Therefore the claim has embodiments which are directed towards non-statutory subject matter. Note MPEP 2106.

Examiner recommends amending the claims to either recite "A non-transitory computer-readable storage medium..." or "A computer-readable storage medium not including carrier waves..." to eliminate all non-statutory embodiments of the claims.

Claims 21-23 are directed towards "A computer readable medium ...". One of ordinary skill would recognize a computer readable medium could be a carrier wave. Therefore the claim has embodiments which are directed towards non-statutory subject matter. Note MPEP 2106.

Examiner recommends amending the claims to either recite "A non-transitory computer readable medium..." or "A computer readable medium not including carrier waves..." to eliminate all non-statutory embodiments of the claims.

Claim Rejections - 35 USC § 103

6. Claims 1-3, 5-6, 8-17 and 20-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Shen et al. (U.S. Patent Application Publication 2003/0149890;

hereafter referred to as "Shen"), and further in view of Bohannon et al. (U.S. Patent 6,134,324; hereafter referred to as "Bohannon") and further in view of Kobata et al. (U.S. Patent Application Publication 2002/0077985; hereafter "Kobata") and further in view of Matsumoto (U.S. Patent 5,897,643).

For claims 1, 11 and 16, Shen teaches a method and computer readable storage medium of storing digitally encoded material, the method comprising:

Employing a processor to execute computer executable instructions stored in memory to perform the following acts (note paragraphs [0034]-[0035]):

Combining a unique identifier with digitally encoded material (note paragraph [0064]) and encrypting the combination of the unique identifier and the digitally-encoded material (note paragraph [0034]); and

Associating a plurality of (note paragraph [0059]) built-in functions (note paragraph [0085]) with the encrypted digitally encoded material such that the unique identifier and the built-in functions are coupled to the digitally encoded material (note paragraph [0034]); and

Rendering or transforming the digitally-encoded material based on the built-in functions (note paragraph [0094]), wherein the digitally-encoded material can be transformed and rendered only by the built-in functions (note paragraph [0017]).

Shen differs from the claimed invention in that they fail to teach:

Storing a list of processors that are permitted to execute the built-in functions;

Receiving information regarding a first processor attempting to execute one or more of the built-in functions;

Verifying if the first processor attempting to execute the built-in functions is on the list of processors; and

Permitting the first processor to execute the one or more built-in functions if the processor is on the list else preventing the first processor from executing the one or more built-in functions.

Bohannon teaches:

Storing a list of processors that are permitted to execute the built-in functions (note column 8, lines 5-7);

Receiving information regarding a first processor attempting to execute one or more of the built-in functions (note column 8, lines 37-38);

Verifying if the first processor attempting to execute the built-in functions is on the list of processors (note column 8, lines 38-40); and

Permitting the first processor to execute the one or more built-in functions if the processor is on the list else preventing the first processor from executing the one or more built-in functions (note column 8, lines 40-47).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the built in functions of Shen and the processor verification of Bohannon. One of ordinary skill would have been motivated to combine Shen and

Bohannon because verifying the processor is on a list of authorized processors would ensure that only licensed computers are handling the content (note column 3, lines 19-23 of Bohannon).

The combination of Shen and Bohannon differs from the claimed invention in that they fail to teach:

Wherein the unique identifier persists throughout the lifetime of the digitally-encoded material, regardless of any changes made to any portion of the digitally-encoded material; and

Wherein at least one of the built-in functions is configured to automatically notify a selected entity when a specified built-in function has been executed or when execution has been attempted.

Kobata teaches:

Wherein the unique identifier persists throughout the lifetime of the digitally-encoded material (note paragraphs [0099] and [0124]), regardless of any changes made to any portion of the digitally-encoded material (note paragraph [0125]); and

Wherein at least one of the built-in functions (note paragraph [0125]) is configured to automatically notify a selected entity when a specified built-in function has been executed or when execution has been attempted (note paragraphs [0127]-[0128]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the combination of Shen and Bohannon and the lifetime identifiers of Kobata. One of ordinary skill would have been motivated to combine Shen, Bohannon and Kobata because tracking the digital content allows the file protection system to completely control and manage the digital rights for the lifetime of the digital content (note paragraph [0224] of Kobata).

The combination of Shen, Bohannon and Kobata differs from the claimed invention in that they fail to teach:

wherein the unique identifier further persists in copies and other derived digitally-encoded material such that copies and derived digitally-encoded material include both the unique identifier of the digitally-encoded material and a new unique identifier for the copy or derived digitally-encoded material.

Matsumoto teaches:

wherein the unique identifier further persists in copies and other derived digitally-encoded material such that copies and derived digitally-encoded material include both the unique identifier of the digitally-encoded material and a new unique identifier for the copy or derived digitally-encoded material (note column 6, lines 3-26).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the combination of Shen, Bohannon and Kobata and the original and new document IDs of Matsumoto. One of ordinary skill would have been motivated to combine Shen, Bohannon, Kobata and Matsumoto because it would provide a way to manage the copy relationship of documents (note column 1, lines 32-67 of Matsumoto).

For claims 6 and 21, the combination of Shen, Bohannon, Kobata and Matsumoto teaches a method and computer readable medium for tracking digitally encoded material, the method comprising:

Employing a processor to execute computer executable instructions stored in memory to perform the following acts (note paragraphs [0034]-[0035] of Shen):

Appending a unique identifier to the digitally encoded material (note paragraph [0064] of Shen), wherein the unique identifier persists throughout the lifetime of the digitally-encoded material (note paragraphs [0099] and [0124] of Kobata), regardless of any changes made to any portion of the digitally-encoded material (note paragraph [0125] of Kobata), **and wherein the unique identifier further persists in copies and other derived digitally-encoded material such that copies and derived digitally-encoded material include both the unique identifier of the digitally-encoded material and a new unique identifier for the copy or derived digitally-encoded material** (note column 6, lines 3-26 of Matsumoto);

encrypting a combination including the digitally encoded material and the unique identifier (note paragraph [0034] of Shen); and

appending built-in function source code (note paragraph [0085] of Shen) to the encrypted combination to form an executable entity (note paragraph [0037] of Shen) capable of being executed independent of a particular operating system (note paragraph [0015] of Shen), wherein the digitally-encoded material can be transformed and rendered only by the built-in functions (note paragraph [0017] of Shen) and wherein at least one of the built-in functions (note paragraph [0125] of Kobata) is configured to automatically notify a selected entity when a specified built-in function has been executed or when execution has been attempted (note paragraphs [0127]-[0128] of Kobata);

Storing a list of processors that are permitted to execute the built-in functions (note column 8, lines 5-7 of Bohannon);

Receiving information regarding a disparate processor accessing the built-in function source code for execution (note column 8, lines 37-38 of Bohannon);

allowing the disparate processor to execute a function associated with the built-in function source code if the disparate processor is included in a list of processors permitted to execute the function (note column 8, lines 38-47 of Bohannon);

barring the disparate processor from executing the function associated with the built-in function source code if the disparate processor is not included in the list of processor permitted to execute the function (note column 8, lines 38-47 of Bohannon).

For claims 2-3 and 17, the combination of Shen, Bohannon, Kobata and Matsumoto teaches claims 1 and 16 further comprising:

Associating a history of the digitally encoded material with the digitally encoded material, wherein the history being located in a database (note paragraphs [0127]-[0128] of Kobata).

For claims 5, 12 and 20, the combination of Shen, Bohannon, Kobata and Matsumoto teaches claims 1, 11 and 16 further including an encrypt function (note paragraph [0015] of Shen) and a decrypt function (note paragraph [0032] of Shen) the built-in functions that enables the digitally encoded material to be stored in RAM in an encrypted form (note paragraph [0094] of Shen).

For claims 8 and 13, the combination of Shen, Bohannon, Kobata and Matsumoto teaches claims 6 and 11 wherein the built-in functions include rendering functions (note paragraph [0094] of Shen) and transform functions (note paragraph [0032] of Shen).

For claims 9 and 14, the combination of Shen, Bohannon, Kobata and Matsumoto teaches claims 8 and 13 wherein the rendering functions include one or more of a close, find shape, full screen, go to guide, help, open (note paragraph [0094]

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of Shen), order pan, properties, reveal, rotate/flip, search, select, size, and position, spell check or zoom.

For claims 10 and 15, the combination of Shen, Bohannon, Kobata and Matsumoto teaches claims 8 and 13 wherein the transform function include one or more of copy, DRM agent (note paragraph [0032] of Shen and paragraph [0115] of Kobata), export, insert, log, new, paste, print, replace, or save as.

For claim 22, the combination of Shen, Bohannon, Kobata and Matsumoto teaches claim 21 wherein the method further comprise:

tracking the digitally encoded material by maintaining an auditable document history log (note paragraphs [0127]-[0128] of Kobata).

For claim 23, the combination of Shen, Bohannon, Kobata and Matsumoto teaches claim 22 wherein the auditable document history log is maintained in one of a file associated with the digitally-encoded material and a database independent of the digitally-encoded material (note paragraphs [0127]-[0128] of Kobata).

For claim 24, the combination of Shen, Bohannon, Kobata and Matsumoto teaches claim 10, including the copy function in the transform functions wherein upon executing the copy function a second unique identifier is generated and appended to a generated copy of the digitally encoded material such that the copy comprises the

unique identifier and the second unique identifier (note column 6, lines 3-26 of Matsumoto).

For claim 25, the combination of Shen, Bohannon, Kobata and Matsumoto teaches claim 24, wherein executing the copy function updates document history of the digitally encoded material and the generated copy (note paragraphs [0127]-[0128] of Kobata) and informs at least an author of the digitally encoded material of the generated copy (note paragraphs [0129]-[0131] of Kobata)).

7. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shen, Bohannon, Kobata and Matsumoto as applied to claims 1 and 6 above, and further in view of Rabinovitch (U.S. Patent Application Publication 2006/0101521).

For claims 4 and 7, the combination of Shen, Bohannon, Kobata and Matsumoto differs from the claimed invention in that they fail to teach:

wherein the built-in function includes one or more of Copy, Paste or Print.

Rabinovitch teaches:

wherein the built-in function includes one or more of Copy, Paste or Print (note paragraph [0047]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the combination of Shen, Bohannon, Kobata and Matsumoto and the copy and print control functions of Rabinovitch. One of ordinary skill in the art would have been motivated to combine Shen, Bohannon, Kobata, Matsumoto and Rabinovitch because it would increase the management of the digital content by allowing control over copying and printing of the content.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. PEARSON whose telephone number is (571)272-0711. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm; off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David J Pearson/
Examiner, Art Unit 2437